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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|-------------------------|------------------|
| 10/068,793 | 02/06/2002 | Robert C. Yen | RCY1P004 | 7468 |
| 22434 | 7590 | 03/25/2004 | EXAMINER | |
| BEYER WEAVER & THOMAS LLP | | | HASHEM, LISA | |
| P.O. BOX 778 | | | | |
| BERKELEY, CA 94704-0778 | | | ART UNIT | PAPER NUMBER |
| | | | 2645 | |
| | | | DATE MAILED: 03/25/2004 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/068,793

Applicant(s)

YEN, ROBERT C.

Examiner

Lisa Hashem

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,6-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2,6-10 and 12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 3-5, 11 and 13-16 have been canceled, as noted in the Preliminary Amendment received on May 9, 2002.

1. Claims 2, 6-10, and 12 are pending in this office action.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim 2, drawn to a system for identifying the geographical cellular area and the wireless network carrier of a mobile wireless device user, classified in **class 455, subclass 422.1**.

II. Claims 6-10 and 12, drawn to a system for reducing bandwidth requirements for requested web content based on subscriber's bandwidth options, classified in **class 709, subclass 203**.

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.

- In the instant case, invention I has separate utility than invention II, such as the invention associated with a system for identifying the geographical cellular area and the wireless network carrier of a mobile wireless device user using a bank of wireless cell phones and/or transceivers in each geographical area.
- Invention II has separate utility than invention I, such as the invention associated with a system for reducing bandwidth requirements for requested web content based on subscriber's defined level of resolutions and compression scheme.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate status in the art because of their recognized divergent subject matter, and the search required for each invention is not required for the other, restriction for examination purposes as indicated is proper. See MPEP § 806.05(d).

5. During a telephone conversation with Applicants' representative, C. Douglass Thomas (Reg. No. 32,947) on March 12, 2004 a provisional election was made without traverse to prosecute the invention of Group II, claims 6-10 and 12. Affirmation of this election must be made by applicant in replying to this Office action. Claim 2 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 6-10 and 12 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent Application Publication No. US 2002/0016818 by Kirani et al, hereinafter Kirani.

Regarding claim 6, Kirani discloses a method for reduction of bandwidth requirements based on user's defined level of resolutions and compression scheme (page 5, column 2, section 0066, lines 1-5), the method comprising: establish one or multiple buffer memory storage space for each mobile wireless internet service subscriber/user at servers of a mobile wireless internet

Art Unit: 2645

service provider (page 5, column 2, section 0066, lines 5-15); and establish a web page or other means from the mobile wireless internet service provider to provide the subscriber/user bandwidth trade-off options to be applied to requested web content (page 5, column 2, section 0066, lines 16-23).

Regarding claim 7, a method as recited in claim 6 mentioned above, wherein Kirani further discloses the bandwidth trade-off options are inherently presented to the subscriber/user as a table or list (page 5, column 2, section 0066, lines 19-23; page 6, column 1, section 0070, line 1 - page 6, column 1, section 0075, line 3).

Regarding claim 8, a method as recited in claim 6 mentioned above, wherein Kirani further discloses the bandwidth trade-off options pertain to one or more of different color tones and/or monochrome tones, different resolution levels, and different data compression options (page 5, column 2, section 0066, lines 1-5; page 5, column 2, section 0069, line 1 – page 6, column 1, section 0069, line 5).

Regarding claim 9, a method as recited in claim 6 mentioned above, wherein Kirani further discloses said method further comprises: temporary storage of the complete or partial web page data requested by the mobile wireless internet subscriber/user and transmitted by the remote web host sites (page 5, column 2, section 0066, lines 5-15; page 5, column 1, section 0067, lines 1-12).

Regarding claim 10, a method as recited in claim 9 mentioned above, wherein Kirani further discloses the temporary storage of the complete or partial web page data are stored at the servers of the mobile wireless internet service provider (see Figure 3; page 6, column 1, section

Art Unit: 2645

0080, line 1 – page 6, column 2, section 0080, line 9; page 6, column 2, section 0093, line 1 – page 7, column 1, section 0095, line 16).

Regarding claim 12, Kirani discloses a method for mapping and comparing characteristics of web page data (page 1, column 1, section 0006, lines 1-12) requested by a mobile wireless internet service subscriber/user to user set options/criteria and the bandwidth available for the mobile wireless transmission of such web page data to the user's mobile wireless internet device (see Abstract; page 2, column 2, section 0036, line 1 – page 3, column 1, section 0036, line 9).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent Application Publication No. US 2003/0072299 by Hunt et al disclose techniques for transmitting graphical images in a network environment wherein the amount of data of said images that is transmitted is customized in accordance with client and/or server criteria

9. Any response to this action should be mailed to:

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Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

Art Unit: 2645

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

March 17, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

